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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/074,012	05/05/1998	SHIGEYOSHI YOSHIDA	0694-121	1497

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EXAMINER

PIANALTO, BERNARD D

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 03/11/2003

43

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/074,012

Applicant(s)

YOSHIDA ET AL.

Examiner

Bernard D Pianalto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102/ 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 11, 15 and 17-21 rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hartman for the same reasons as urged in the action of 12-4-02.

Claims 10 and 11 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either goto et al or Horie for the same reasons as urged in the action of 11-15-02.

Claims 10-13 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takahashi et al for the same reasons as urged in the action of 11-15-02.

Claim Rejections - 35 USC § 103

Claims 12, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman, Horie et al or Goto et al In view of Takahashi et al for the same reasons as urged in the action of 11-15-02.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman in view of either Ogawa et al or Takahashi et al for the same reasons as urged in the action of 11-15-02.

Response to Arguments

Applicant's arguments filed 3-4-03 have been fully considered but they are not persuasive. Applicants argue on page 4, lines 1-3 that "Hartman neither discloses nor teaches any electromagnetic interference suppression. The examiner is not convinced by this argument. It is the examiners opinion that electromagnetic interference suppression would be inherent in the system of Hartman. In addition, the presently claimed property of electromagnetic interference suppression would obviously have been present once the Hartman system is provided. Note In re Best, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

Applicants further argue in the first full paragraph on page 4 of their remarks that "the particles of Hartman are not dispersed". The examiner is not convinced by this argument since Hartman disperses particles in a binder as step one of his process. In step two the composition having dispersed particulate material is subjected to a magnetic field to orient the particle. Applicants' claimed "dispersed through out encompasses the first step as well as the second step of the reference. The dictionary

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defines disperse as "to distribute more or less evenly through-out a medium". The dispersion of step one as well as that of step two are encompassed by the dictionary definition. Other definitions of dispersed are not limited to "evenly". Applicants have not defined an evenly dispersed system.

Applicants further argues in the last full paragraph that "a magnetic recording medium cannot serve as the electromagnetic interference suppressor". The examiner is not convinced by this argument since the layer that is not the magnetic recording layer may be composed of two particles such as soft magnetic material and aluminum oxide. The magnetic layer of Goto et al is encompassed by the claimed electronic device.

Applicants further argue in the paragraph bridging pages 6 and 7 of their response that "Goto et al only discusses soft magnetic particles ... in the magnetic layer". The examiner is not convinced by this argument since Goto et al discloses in col. 8, lines 20-30 a layer comprising two non-magnetic material particles and in col. 3, lines 1-15 discloses that soft magnetic material and for example aluminum oxide are equivalent in the choice of a non-magnetic particulate material.

Applicants further argue in the third full paragraph on page 8 of their remarks that "Horie cannot be used as an electromagnetic interference suppressor". The examiner is not convinced by this argument since Hori discloses soft magnetic particles and aluminum oxide dispersed in a binder and is associated with an electronic device. If Applicants claims act as a suppressor the same must be true of the reference process. Applicants finally argue that Ogawa et al and Takahashi et al "are deficient for the same reasons as Goto et al. The examiner is not convinced by this argument since both

disclose material such as aluminum oxide and iron dispersed in a binder to form a layer and is associated with an electronic device.

In further response to applicant's argument that Ogawa and Takahashi are deficient for the same reasons as Goto et al, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In further response to applicant's argument that the references have different uses, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard D Pianalto whose telephone number is 703 308 2332. The examiner can normally be reached on 5:30-6:00 Mon-Wed.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 703 308 2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 306 5665.

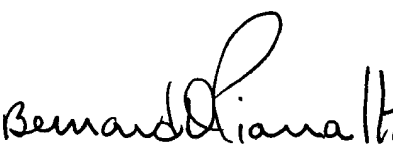
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March 10, 2003 .


BERNARD PIANALTO
PRIMARY EXAMINER